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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/488,653	01/20/2000	Jun Tanaka	JA998-227	4753

7590 12/16/2004

Anne Vachon Dougherty
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EXAMINER

BROWN, CHRISTOPHER J

ART UNIT	PAPER NUMBER
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2134

DATE MAILED: 12/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/488,653

Applicant(s)

TANAKA ET AL.

Examiner

Christopher J Brown

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4,6-12,21-26 and 28-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4,6-12,21-26 and 28-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 January 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 112

2. Claims 7-12 and 21-26, are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 7, 9, 10 and 12 all state within the first 5 lines "security device removably installed therein". This is indefinite as "removably" and "installed" seem to have polar opposite definitions. The examiner interprets this phrase as "a removable security device installed therein".

Claims 8, and 11 are also rejected due to their dependence on Claims 7, and 10.

Claims 21-26 are rejected due to their dependence on previously cancelled claims.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

As per claims 1, 6, Isikoff discloses a security method to prohibit access to a computer when a security device (beacon/PCMCIA Card) has been removed from said computer, (Col 4 lines 45-49). Isikoff discloses storing data in a first storage means (firmware) in which only authorized users are able to change (Col 4 lines 45-50). Isikoff discloses dynamically determining if the security device (beacon) is removed or altered on said computer, and if so, prohibiting access, (Col 4 lines 50-53).

Isikoff does not teach an RFID.

Elledge teaches using an RFID tag in a laptop, (Col 7 lines 12-21, Fig 4).

It would have been obvious to one of ordinary skill in the art to add the RFID tag to the laptop of Isikoff because the tag helps to recover the stolen laptop, (Col 1 line 20-25).

Kunert teaches that a PCMCIA card has an RF transponder in it (Col 1 lines 26-36).

It would have been obvious to combine the PCMCIA card of Kunert with the beacon of Isikoff because the card of Kunert reduces electromagnetic interference, (Col 3 lines 20-25).

As per claim 2, Isikoff teaches that prohibiting computer use is caused by a trigger event (removing beacon), (Col 4 lines 50-53)

As per claims 3, and 4 Isikoff discloses password authorization to determine whether access to the computer should be prohibited, (Col 4 lines 52-55). Although not explicitly stated, data must be recorded or the computer would automatically think that the beacon had been stolen.

As per claims 8, and 11, and 30, Isikoff teaches determining whether the removal of the security device was authorized, (Col 4 lines 50-55). Although not explicitly stated, data must be recorded or the computer would automatically think that the beacon had been stolen.

As per claims 4, 8, 11, and 30 Isikoff discloses that the security device (beacon) is able to determine if it was legitimately removed from the computer (Col 4 lines 45-49).

As per claims 7, 9 and 10, Isikoff discloses a security method to prohibit access to a computer when a security device (beacon/PCMIA Card) has been removed from said computer, (Col 4 lines 45-49). Isikoff discloses storing data in a first storage means (firmware) in which only authorized users are able to change (Col 4 lines 45-50). Isikoff discloses dynamically determining if the security device (beacon) is removed or altered

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on said computer, and if so, prohibiting access, (Col 4 lines 50-53). Isikoff teaches a battery backup to the security beacon, (Col 9 lines 15-17). Isikoff teaches storage means to store a program for security functions, (Col 6 lines 25-30).

Isikoff does not teach an RFID.

Elledge teaches using an RFID tag in a laptop, (Col 7 lines 12-21, Fig 4). Elledge teaches that the RFID tag (RIC) has memory to store data, and a battery to stay powered even when the power to the computer is off (Col 4 lines 55-65).

It would have been obvious to one of ordinary skill in the art to add the RFID tag to the laptop of Isikoff because the tag helps a user to recover a stolen laptop, (Col 1 line 20-25).

Kunert teaches that a PCMCIA card has an RF transponder in it (Col 1 lines 26-36).

It would have been obvious to combine the PCMCIA card of Kunert with the beacon of Isikoff because the card of Kunert reduces electromagnetic interference, (Col 3 lines 20-25).

As per claims 21-26, Kunert teaches that the RF antenna is attached to the PCMCIA card that resides in the PCMCIA bay, (Col 1 lines 26-36).

As per claims 28 and 29 Isikoff discloses that remote actions may be made using RF signals, (Col 9 lines 59-64).

Allowable Subject Matter

4. Claim 12 would be allowable if rewritten to overcome the 112 rejection.

Conclusion

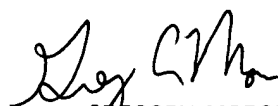
5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher J Brown whose telephone number is 703-305-8023. The examiner can normally be reached on 8:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Morse can be reached on 703-308-4789. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Christopher J. Brown

12/9/04



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